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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,000	08/15/2006	Andrei Mijiritskii	NL 040146	8973

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BRIARCLIFF MANOR, NY 10510

EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,000

Applicant(s)

MIJIRITSKII ET AL.

Examiner

GERARD T. HIGGINS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) 7-13 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 12/01/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-6 in the reply filed on 05/19/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 7-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/19/2008.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **14**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The use of the trademark BLU-RAY DISC has been noted in this application (pg. 5, line 18 and pg. 7, lines 13-14). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the terms "substantially transparent" and "locally illuminating" are relative terms which render the claim indefinite. The terms "substantially transparent" and "locally illuminating" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how much transparency is required to be substantially transparent and how local the illumination must be to comprise the limitations of the claim.

With regard to claim 5, the terms "locally illuminating" and "substantially different" are relative terms which render the claim indefinite. The terms "locally illuminating" and "substantially different" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

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not be reasonably apprised of the scope of the invention. It is unclear how different the wavelength must be in order to be substantially different and how local the illumination must be to comprise the limitations of the claim.

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

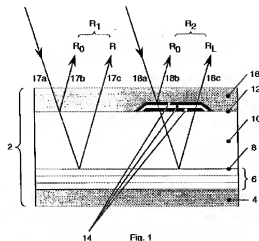
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sullivan et al. (5,510,163).

With regard to claim 1, Sullivan et al. disclose the optical recording medium of Figure 1.



The device is comprised of a data layer **6** and a transparent layer **16** and **10** (col. 6, lines 4-21). The data is retrievable through the transparent layer as can be seen by the arrows in the Figure, and additionally as stated at col. 5, lines 6-45. The transparent layer comprises a label material **14** on the read-side of the disc. The label material can be deposited through a mask, a dielectric coating, or a photolithographically etched layer (col. 6, lines 10-21). The Examiner deems a photolithographically etched layer would comprise a layer "characterized in that the reflection or absorption is affectable by locally illuminating the label material for the forming of the label."

The Examiner deems the limitation "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum" as an intended use limitation. While there is no disclosure that the label material is "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum" as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for

example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum," recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art label material and further that the prior art structure which is a label material identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose a label material that would be exposed at any wavelength, including the visible wavelengths claimed. The fact that the material is developed at visible wavelengths does not affect the fact that the end result is a label material that shows optical contrast (indicia), while still allowing readout of the data layer.

With regard to claim 2, the layer **14** is a distinct layer formed between two transparent layers, and therefore anticipates this claim.

With regard to claim 4, an organic dye can be used (col. 6, line 14).

With regard to claim 5, the photolithographic exposure on any of the discs of Sullivan et al. would necessarily have to be at a different wavelength from the read and writing laser wavelengths. This is necessarily true because if it was the same wavelength as either the read or write laser beams it would destroy the recording layer.

With regard to claim 6, Sullivan et al. disclose at col. 8, lines 7-24 that multiple layers can be used to make a logo that is more complex and colorful. Considering they disclose using organic dyes in this section, and therefore multiple organic dyes, these organic dyes would have to be exposed and developed, which would inherently change their reflection and absorption properties; however, the Examiner considers these limitations regarding the wavelengths at which the layers are affected to be intended use limitations. While there is no disclosure that the label materials are capable of being affected by illuminating the material at first and second wavelengths as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the

purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. capable of being affected by illuminating the material at first and second wavelengths, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art label materials and further that the prior art structure which are label materials identical to that set forth in the present claims are capable of performing the recited purpose or intended use.

12. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lawandy et al. (US 2003/0012562).

With regard to claim 1, Lawandy et al. teach a logo or information containing layer on the read-side of an optical recording medium [0037]. They disclose at [0037] that the coating may be applied to a CD or DVD. A CD or DVD will inherently possess a data layer. The coating layer is equivalent to the transparent layer as it does not affect the readout system [0048], and therefore it will also allow data to be retrieved. The transparent layer may comprise the label materials seen at [0047] and [0078]. One embodiment of Lawandy et al. teaches photobleaching of the fluorescent additives in a polymeric matrix using an UV laser seen at [0078], which would comprise a layer

"characterized in that the reflection or absorption is affectable by locally illuminating the label material for the forming of the label."

The Examiner deems the limitation "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum" as an intended use limitation. While there is no disclosure that the label material is "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum" as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. "for forming a label at a laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum," recited in the present claims does not result in a structural difference between the presently claimed

invention and the prior art label material and further that the prior art structure which is a label material identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose a label material that would be photobleached at any wavelength, including the visible wavelengths claimed. The fact that the claimed material is photobleached at visible wavelengths does not affect that the end result is a label material that shows optical contrast (indicia), while still allowing readout of the data layer.

With regard to claim 3, Lawandy et al. disclose at [0078] that the label material is dispersed in a polymer matrix.

With regard to claim 4, the materials mentioned at [0047] include organic photosensitive materials.

With regard to claim 5, the photobleaching mentioned at [0078] may be done by a UV laser; this would be a wavelength substantially different from a wavelength of the reading or writing laser beams [0048].

Claim Rejections - 35 USC § 103

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (5,510,163) as applied to claim 1, in view of Lawandy et al. (US 2003/0012562).

Sullivan et al. disclose all of the limitations of claim 1 in section 11 above; however, it fails to disclose label material dispersed in a substrate layer for constituting a label material layer.

Lawandy et al. disclose at [0078] that the label material may be dispersed in a polymer matrix.

Since Sullivan et al. and Lawandy et al. are both drawn to logos or indicia on the read-side of an optical recording medium; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the dispersed label material in a polymeric matrix of Lawandy et al. as the label material layer of Sullivan et al. The result of such a combination would have been predictable to one having ordinary skill; further, each of the elements would have performed the same in combination as they had separately. The motivation for using the label material layer of Lawandy et al. is that the device can be made cheaper because one less layer needs to be formed; further, the optical recording medium would have more structural integrity.

14. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. (US 2003/0012562), as applied to claim 1, in view of Sullivan et al. (5,510,163).

Lawandy et al. disclose all of the limitations of applicants' claim 1 in section 12 above; however, they fail to disclose a situation where the transparent layer comprises at least one substrate layer and at least one label material layer, and they also fail to disclose using multiple label materials that are affected at multiple wavelength ranges.

Sullivan et al. disclose the layer **14** in Figure 1 (please see section 11 above), which is a distinct layer formed between two transparent substrate layers.

Sullivan et al. disclose at col. 8, lines 7-24 that multiple layers can be used to make a logo that is more complex and colorful. In this section they also disclose that multiple organic dyes may be used.

With regard to claim 2, since Lawandy et al. and Sullivan et al. are both drawn to logos or indicia on the read-side of an optical recording medium; it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the transparent layer of Lawandy et al. with at least one substrate layer and at least one label material layer as taught by Sullivan et al. The results of such a substitution would have been predictable to one having ordinary skill. The motivation for doing so can be found at col. 5, lines 6-25 of Sullivan et al. where they state that this arrangement of layers is done to prevent counterfeiting of the optical recording media of their invention.

With regard to claim 6, since Lawandy et al. and Sullivan et al. are both drawn to logos or indicia on the read-side of an optical recording medium; it would have been obvious to one having ordinary skill in the art at the time the invention was made to use multiple label materials as taught by Sullivan et al. to achieve a more colorful appearance to the label material layer. The motivation for doing so can be found at col. 8, lines 15-17 of Sullivan et al. where they state that multiple label material make the structure more difficult to counterfeit.

With regard to the limitation that the materials reflection and absorption would be affected at different wavelengths, the organic dyes of different colors of Sullivan et al. would intrinsically be affected at different wavelength specifically because of that color difference; furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to perform a mere duplication of parts and use two different photobleachable materials of Lawandy et al. to effectuate a more colorful appearance of the label material layer. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Choosing two different photobleachable materials of different colors would not result in a new or unexpected result. In this same regard, the Examiner deems that two different photobleachable materials of different colors would intrinsically be affected at different wavelength ranges; further, it still would have been obvious to one having ordinary skill to choose the photobleachable materials such that they would be individually targetable by the writing beam, and as such would be sensitive to light in two different wavelength ranges. Individually targeting the photobleachable materials would allow for a label material layer that was more aesthetically pleasing to the consumer and more difficult to counterfeit.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 0290750 relates to light sensitive dyes, wherein ultraviolet light is used to affect visible color changes. The other cited but not used art relates to digital watermarks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins, Ph.D.
Examiner
Art Unit 1794

/Gerard T Higgins, Ph.D./
Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794